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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,374	09/08/2000	Michael D. Peterson	NFTIN-9	3566

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MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
2200 CLARENDON BLVD.  
SUITE 1400  
ARLINGTON, VA 22201

EXAMINER

HYLTON, ROBIN ANNETTE

ART UNIT PAPER NUMBER

3727

DATE MAILED: 08/13/2004

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GROUP 3700

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Application Number: 09/658,374  
Filing Date: September 08, 2000  
Appellant(s): PETERSON ET AL.

\_\_\_\_\_  
John R. Moses  
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 3, 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of the claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Invention**

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is essentially correct.

However, it is noted that the rejections of claim 1 under 35 USC 103 as being obvious over Wickland '304 in view of Kalota and Finkelstein or McKedy and Wickland et al. '050 are hereby withdrawn by the examiner. This effectively reduces the issues on appeal.

**(7) Grouping of Claims**

Appellant's brief includes a statement that the grouping of claims 15-17 and 19 and the grouping of claims 1-13 and 18 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

4,500,328	BRASSELL et al.	2-1985
4,996,369	KALOTA et al.	2-1991
5,353,949	SEIBERT et al.	10-1994

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5,686,700	CARPINELLA	11-1997
5,727,707	WICKLAND et al.	3-1998
5,839,593	McKEDY	11/1998
6,041,669	BRASSELL et al.	3-2000
6,139,931	FINKELSTEIN et all.	10-2000

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-13 and 15-20 are rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in a prior Office Action, mailed on June 17, 2003.

Claims 1,2,7, and 18-20 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on June 17, 2003.

Claims 3-7 and 15 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on June 17, 2003.

Claims 8,10,16, and 17 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on June 17, 2003.

Claims 9 and 10 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on June 13, 2003.

Claims 1,2,12,13, and 18-20 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on June 17, 2003.

Claims 3-7 and 15 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on June 17, 2003.

Claims 8,10,16, and 17 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on June 17, 2003.

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Claims 9 and 11 are rejected under 35 U.S.C. 103. This rejection is set forth in a prior Office Action, mailed on June 17, 2003.

**(11) Response to Argument**

Regarding appellant's arguments to the rejection under 35 USC 112, first paragraph, it is noted that the appellant is relying on the drawings for evidence of originally filed support to the subject matter of "direct contact" between the filter and the housing. While figures 3 and 8 may not show other structure, it should be born in mind that patent drawings rarely illustrate adhesive layers between two structural elements. Therefore, direct contact may or may not be true in the instant application.

Regarding the comparative examples, example 2 does not state an additional element is present between the filter and the vent nor does it state there is not an additional element. The description merely asserts the carbon-to carbon filter becomes plugged. This could be due to deterioration of the filter or because of the contents of the container being vented.

Regarding appellant's remarks directed to the rejection of claims 1,2,7, and 18-20 (found in paragraph 8 of the Office action), it is submitted that the use of RTV is not required by the filter enclosure of Brassell. This is a recitation of a preferred adhesive that can be utilized. Thus, the reference does not teach away from the claimed instant invention as asserted by appellant.

Additionally, it is submitted that it has been established that using a known material on the basis of its suitability for the intended use as a matter of obvious design choice and such knowledge is within the general skill of a worker in the art. *In re Leshin*, 125 USPQ 416. Wherein applicant has not provided unexpected results from the use of nickel-molybdenum chromium alloy, one of ordinary skill in the art at the time of the invention would have used the

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teaching of Kalota to provide a corrosion resistant enclosure formed from nickel-molybdenum chromium alloy.

Lastly, Finkelstein and McKedy are relied upon only for the teaching of directly attaching a *media* to an enclosure. Although Finkelstein and McKedy are not directed to a “filter” media, they both teach **directly attaching** a media to a housing. Thus, one of ordinary skill in the art would utilize this teaching for directly attaching a media to a housing.

Regarding appellant’s remarks directed to the rejection of claims 3-7 and 15 (found in paragraph 9 of the Office action), it is noted that Wickland ‘707 is provided only for its teaching of a perforated lid. The use of an adhesive to secure the filter within the housing is at issue with respect to the rejection.

Regarding appellant’s remarks directed to the rejection of claims 1,10,16 and 17 (found in paragraph 10 of the Office action) and claims 9 and 11 (found in paragraph 11 of the Office action), no specific comments are provided by the examiner since applicant merely asserts the further teachings therein do not “cure the deficiencies” of the base rejections. The examiner disagrees with the assertion that the base rejections have deficiencies. The rejections as set forth in the Office action and further stated herein, should be affirmed.

Regarding appellant’s remarks directed to the rejection of claims 1,2,12,13, and 18-20 (found in paragraph 12 of the Office action), it is pointed out that the disclosure of the vent housing of Brassell does not specifically set forth structure in the specification with regard to first and second openings and a unitary filter. It is inherent, however that a vent housing by nature must have two openings to allow venting to occur. The structure of Brassell ‘328 has been relied upon for its explicit teaching of two openings and a unitary filter.

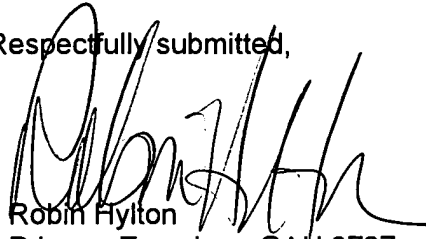
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Again, the material of the vent housing is an obvious matter of design choice as previously set forth above. The teaching of directly attaching a media to a housing also be addressed above.

It is noted that the rejections of claim 1 under 35 USC 103 as being obvious over Wickland '304 in view of Kalota and Finkelstein or McKedy and Wickland et al. '050 are hereby withdrawn by the examiner.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,




Robin Hylton  
Primary Examiner, GAU 3727

August 9, 2004

Conferees

  
Lee Young,  
SPE GAU 3727

  
Nathan Newhouse  
Primary Examiner, GAU 3727

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
2200 CLARENDON BLVD.  
SUITE 1400  
ARLINGTON, VA 22201